

**REMARKS**

By this Amendment, claims 1, 11, 13, and 23 are amended, and claims 31–35 are canceled without prejudice to or disclaimer of the subject matter contained therein. Accordingly, claims 1–30 are pending. Claims 31–35 have previously been withdrawn from consideration. Reconsideration of the present application is respectfully requested.

Applicants gratefully acknowledge that the Office Action indicates that claims 13, 16, and 17 contain allowable subject matter. Claim 13 is rewritten in independent form to expedite prosecution of the above-identified patent application.

Support for the feature added to claims 1, 11, and 23 can be found, for example, in paragraph [0040], and Figures 2 and 4. The added feature provides language to connect the shaft to the other features in each of the claims. Applicants believe that the claims originally submitted in the application are patentable over the applied reference.

**I. The Claims Define Allowable Subject Matter**

The Office Action rejects claims 1–4, 7, 11, 12, 14, 23, and 24 under 35 U.S.C. §102(b) over U.S. Patent No. 3,325,107 to Peterson, and claims 5, 6, 8–10, 15, 18–22, and 25–30 under 35 U.S.C. §103(a) over Peterson. These rejections are respectfully traversed.

With respect to claims 1, 11, and 23, Peterson does not disclose each and every feature of the particle refining apparatus or system as defined in the claims. The Office Action merely states that “Figure 1 shows a rotary blade assembly housed in a conduit to shred material fed thereto.” Office Action at p. 3, lines 2–3. Applicants are unsure what parts of Peterson the Examiner is relying on to show, for example, the conduit, housing, and containment device. The Applicants respectfully request the Examiner to specify which parts of Peterson are being used to reject the pending claims so that a proper response can be submitted.

In addition, Applicants note that the Office Action has provided no teaching or suggestion in the prior art that would have been obvious to one of ordinary skill in the art to modify Peterson to obtain the features found in claims 5, 6, 8–10, 15, 18–22, and 25–30. Applicants submit that these features of claims 5, 6, 8–10, 15, 18–22, and 25–30 are not obvious to one of ordinary skill in the art.

MPEP § 2143.01 instructs that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” In the same section it states: “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” The section further instructs that “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicants respectfully submit that the rejection of claims 5, 6, 8–10, 15, 18–22, and 25–30 are improper in view of MPEP § 2144.03 because it lacks evidence of a teaching or suggestion that the features would have been obvious to one of ordinary skill.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§102 and 103 should be withdrawn because the applied reference does not teach or suggest each feature of the pending claims.

As pointed on in MPEP §2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

*Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).”

Similarly, MPEP §2143.03 instructs that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974).”

For at least these reasons, it is respectfully submitted that independent claims 1, 11, and 23 are patentable over the applied reference. The remainder of the claims that depend from independent claims 1, 11, and 23 are likewise patentable over the applied reference for at least the reasons discussed above, as well as for the additional features they recite.

## **II. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the pending claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned representative at the telephone number below.

Any fees incident to this Amendment may be charged to Deposit Account No. 08-2665.

DATED this 10<sup>th</sup> day of March, 2006.

Respectfully submitted,



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